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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/642,413
Filing Date: August 15, 2003
Appellant(s): HUANG, GEORGE Y.

MAILED

FEB 28 2006

GROUP 2800

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/14/2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is aware of a related appeal (parent Application 09/657,869), interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

This appeal involves claims 1 – 12 and 14-16.

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

5735699	Tan	04/07/1998
4704091	Owens et al.	11/03/1987
4256159	Williams	03/17/1981
4275768	Riggs et al.	06/30/1981
5961349	Bienhaur et al.	10/02/1990
4202351	Biche	05/13/1980
4164725	Wiebe	08/14/1979

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims (1 and 12) are rejected under 35 U.S.C. 102(b). Claims (1 - 12) and (14 - 16) are rejected under 35 U.S.C. 103 (a). This rejection is set forth in a prior Office Action, mailed on 07/08/2005.

Claim Rejections - 35 USC § U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tan et al. (5735699).

Tan et al. disclose the device 10 comprises the housing 16 with an outer surface (not marked) and at least one end 22 adapted to hold an electrical connector plug, wherein the housing 16 has a raised portion 29 above the outer surface of the housing 16, a covering 12 formed over the outer surface of the housing 16 and around the raised portion 29, and an exposed part EP (see Attachment 1) of the raised portion 29 is not covered by the covering 12 (see Fig. 3); the exposed part of the raised portion further comprises a background surface BS (see Attachment 1) and a design surface DS (see Attachment 1), and the design surface DS is formed as part of the background surface BS and is not level with the background surface (see Attachment 1).

Attachment 1

EP

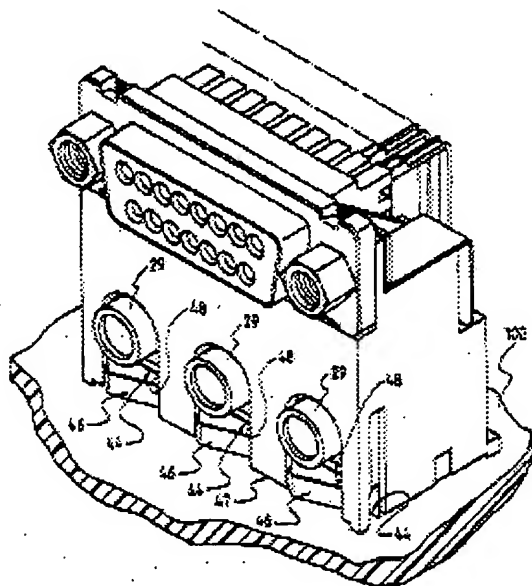


FIG. 3

DS

BS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091).

In regard to claim 1 and 12, Owens et al. disclose the device comprising the housing 12 with an outer surface (not marked) and at least one end adapted to hold an electrical connector plug, wherein the housing 12 has a raised portion 26 above the outer surface of the housing, a covering 14 formed over the outer surface of the housing 12 and around the raised portion 26, and an exposed part of the raised portion 26 is not covered by the covering; the exposed part of the raised portion 26 further comprises a background surface.

Owens et al. do not disclose that the exposed part of the raised portion 26 forms a design surface and that the design surface is formed as part of the background surface and is not level with the background surface. However, Owens does indicate that the surface of a raised portion 26 is intended for use in applying information (see Col.3, lines 55-56). Etching and appliqué are both commonly used methods for applying information. Using either one of these methods would have been obvious

alternatives, since they are easily performed, and use of either technique would result in **a design surface** that is “not level with the background.

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Williams (4256159).

In regard to claims 3 and 14, Owens et al. disclose most of the claimed invention except for that the design surface is a sub-surface design below the background surface.

Williams teaches a design surface 14 below a background surface 13. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 14 formed in the background surface 13 below the background surface 13, as taught by Williams, in the structure of Owens et al. in order to provide some identification information (indicia).

Also, how the design surface is arrange, above or below the background surface, depend only on the method of forming the design surface by adding or subtracting material.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Biche (4202351).

Owens et al. modified by Williams (4256159) include most of invention, except for a design surface formed during molding of the housing. Biche teach a design surface 46, which formed in the background surface 44 by molding with the housing 22 /42 (see

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Biche, Col.2, line 65 and Col5, line 54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 46 formed in the background surface 44 above the background surface 44 in structure of Owens et al., as taught by Biche, in order to provide some identification information (indicia).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Riggs et al. (4275768).

Owens et al. modified by Williams disclose most of invention, except for the sub-surface design is formed by machining. Riggs et al. teach a sub-surface design (an engraving indicia) 20 form by engraving. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a sub-surface design in the background surface in structure of Owens et al. by well-known methods of machining/engraving, as taught by Riggs et al., in order to provide some identification information (indicia).

Note: Examiner considers forming a sub – design surface by engraving or by laser as a machining method.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (4704091) and Williams (4256159), as applied to claim 3 above, and further in view of Beinhaur et al. (4960391).

In regard to claim 6, Owens et al. disclose most of the claimed invention except that above- surface design is formed in the background surface of the raised portion of the housing by stamping. Beinhaur et al. teach a well-known method of stamping of the visible indicia (see Col.2, lines 45-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a above- surface design in the background surface in structure of Owens et al. using well-known method such as stamping, as taught by Beinhaur et al., in order to provide some identification information (indicia).

Claims 7, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Biche (4202351).

In regard to claims 7 and 15, Owens et al. disclose most of the claimed invention except for the design surface being a surface formed in the background surface above the background surface. Biche teaches (raised indicia "RL", see Fig. 7 and Col.2, lines 65-66) a surface 46 formed in the background surface 44 above the background surface 44. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 46 formed in the background surface 44 above the background surface 44, as taught by Biche, in the structure of Owens et al. in order to provide some identification information (indicia).

In regard to claim 8, Owens et al. disclose most of the claimed invention except for that the above-design surface is formed in the background surface of the raised portion of the housing during molding of the housing. However, Owens et al. modified by Biche

include the above-design surface 46, which is formed in the background surface 44 of the raised portion of the housing during molding of the housing 22 /42 (see Biche, Col.2, line 65 and Col.5, line 54).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Biche (4202351), as applied to claim 7 above, and further in view of Riggs et al. (4275768).

Owens et al. modified by Biche disclose most of invention except for that the sub-surface design is formed by machining. Riggs et al. teach a sub-surface design (an engraving indicia) 20 formed by machining (engraving). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a sub-surface design in the background surface in the structure of Owens et al. by well-known method of machining/engraving, as taught by Riggs et al., in order to provide some identification information (indicia).

Note: Examiner considers forming a sub – design surface by engraving or by laser method as a machining method.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Biche (4202351), as applied to claim 7 above, and further in view of Beinhaur et al. (4960391).

In regard to claim 10, Owens et al. disclose most of the claimed invention except the above- surface design is formed in the background surface of the raised portion of the

housing by stamping. Beinhaur et al. teach a well-known method of stamping of the visible indicia. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a above-surface design in the background surface by well-known methods such as stamping, as taught by Beinhaur et al., in the structure of Owens et al. in order to provide some identification information (indicia).

Note: how the design surface is arranged (above or bellow the background surface) depends only on the method of forming the design surface by adding or subtracting material.

Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Wiebe (4164725).

Owens et al. disclose most of the claimed invention except for a design surface formed in the background surface being a gripping surface design. Wiebe teaches a gripping surface 72 to permit one to better grip the component 20.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a design surface as a gripping surface to permit one to better grip the connector and also for better connection with an information plug 26 (affixed) which is designed as identification plaque (see Col.3, line 55) and used for putting information on.

Response to Arguments

Most of Applicant's arguments are based on, as admitted on page 3 of Appeal Brief, that "The invention discloses a connector or adapter housing structure that provides a raised portion that will be exposed after the outer plastic covering is molded onto the connector or adapter. This raised portion of the housing provides a place to incorporate designs such as business logos or gripping surfaces, which can be formed as part of the raised portion The present invention eliminates the need to apply a logo through a second injection molding process or by affixing it in a later manufacturing step." However, the language such "later manufacturing step" or similar language never appeared in the claims 1 and 12. Also, none of the claims disclose how many steps these surfaces were formed.

Regarding rejection of claims 1 and 12 with Tan's reference:

Appellant's argues **on page 10** that Tan shows no such structure as "raised portion" with "background surface" and "design surface", and specifically states that Tan shows no surfaces. The Examiner respectfully disagrees and interprets portion 29 as a raised portion, a circumferential outer surface of a raised portion 29 as a background surface BS, and a front rim of a raised portion 29 as a designed surface DS (see Attachment 1).

Appellant argues **on page 11** that Tan's audio jack (29) is not a "raised portion" and does not have an "exposed part" forming a "background surface", and the rim of the jack does not provide a "design surface". The Examiner respectfully disagrees and

states that Tan et al. clearly discloses that the housing 16 has a raised portion 29, which is above the outer of the housing 16. The Examiner interprets a circumferential outer surface of a raised portion 29 that protrudes outward from a cover 12 as an exposed part EP (see Attachment). The Examiner interprets a circumferential outer surface of exposed part EP of the raised portion 29 as a background surface BS and a front rim of portion 29 as a designed surface DS (see Attachment 1).

Appellant argues on page 12 that Tan does not include any surface, neither background nor design, neither "exposed", level nor lower than any other surface, rather, Tan shows a hollow cylindrical audio jack mating port (29) to receive an audio cable connector. The Examiner disagrees and states that Tan et al. clearly discloses that the housing 16 has a raised portion 29, which is above the outer of the housing 16. The Examiner interprets a circumferential outer surface of exposed part EP of a raised portion 29 as a background surface BS and a front rim of portion 29 as a designed surface DS (see Attachment 1). Moreover, applicant's claim language is broad and does not clearly define the "background surface" and the "design surface. The Examiner states that Tan's reference can be read and meets the claim language.

Appellant argues on page 13 that "the Examiner also argues... the rim of Tan's audio jack could be a surface on which design might be located." The Examiner did not include such a statement. The Examiner only considers the rim of portion 29 as a design surface. Also, Appellant argues that the "circumferential outer surface" cited by the Examiner is not exposed. The Examiner considers that a bracket 12 covers the housing 16 and leaves a part of the "circumferential outer surface" of the raised portion

(audio jack) 29 exposed (see Fig.3) to be analogous to Application and meets the claimed limitations.

Appellant argues on pages 14 – 15 that the structure of Tan is an assembly, that is, a collection of parts (three-in-one integral audio jack), and does not form a housing at all. The Examiner disagrees. A one piece integral housing is a part of claim language, and as such member 16 is deemed meet the limitation.

The Examiner is aware that the Tan structure does not look the same as invention and is used by Examiner only to show that that claim is so broad that can be rejected by using Tan reference.

In addition, the Examiner reminds to the Appellant that regarding claim discloses the instant claimed invention except for method step (one-step molding process), it has been held that even though the claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. [In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985)].

Regarding rejection of claims 1 and 12 with Owens et al. reference:

In response to Appellant's Arguments on page 16, where Appellant quotes the Examiner's phrase that "Owens et al. does not disclose a design surface ...formed as part of the background surface" and "such limitations are unpatentable because they

are “matters relating to ornamentation only which have no mechanical function.” This is not correct, the Examiner does not use this language in the rejection of claim 1. The Examiner mentioned “ornamentation” in “Response to Arguments” in OA dt.7/14/05.

On page 16, Appellant's argues that “Appellant's specification specifically recites the manufacturing advantages...solved the problem of a two –step molding process” and “eliminate a two-step molding process”, which never appeared to be a claimed language. Appellant does not claim a one-step molding process or any method step (except claims 4 and 8).

On same page 16, where Appellant quotes the Examiner's phrase that “Owens et al. does not teach the background and design surface”, Examiner has to admit that Owens's structure perfectly well show that a raised portion 26 has a main planer surface.

On page 17, Appellant argues that Owens et al. does not describe or claimed the “raised planar member” as a structure for incorporating design, logos, etc. The Examiner states that Owens et al. clearly show the claimed structure including the housing 12 with an outer surface (not marked) and at least one end adapted to hold an electrical connector plug, wherein the housing 12 has a raised portion 26 above the outer surface of the housing (“the raised planar informative plaque member 26”, see Abstract, lines 11-12 and Col.3, lines 55-56; it is obvious that term “informative plaque” is a structure for incorporating design, logos, etc.), a covering 14 formed over the outer surface of the housing 12 and around the raised portion 26, and an exposed part of the

raised portion 26 is not covered by the covering. The exposed part of the raised portion 26 further comprises a background surface.

The Examiner does not argue that the Owens' reference teaches how an indicia was applied, but only shows the claimed structure and place to put information (indicia).

On page 19, Appellant argues that the Examiner demonstrates "a stubborn refusal" to consider Appellant's discussion of the prior art, which establishes that the two-step process of applying a logo design, like the "information plaque member 26" described in Owens, adds a manufacturing step, and the Applicant's invention overcomes this problem by forming the logo design in the one-step."

The Examiner maintains that the part of the invention, which includes a manufacturing step, is not in the claims 1 and 12.

Appellant argues that the Examiner "has relied on an unsupported factual assertion that the two-step appliqué process of Owens et al. is as "easily performed" as forming a design in a single step process. The Examiner maintains that the "method step or process" language does not appear in the Claims 1 and 12.

The Examiner points out that the every page of Arguments in the Appeal Brief introduced almost the same arguments, which clearly show that Applicant mixed up his invention, which is disclosed into the Specification, and what Applicant really claimed. There is a discrepancy between the Claimed language and Arguments.

On page 20, Appellant argues that the Examiner does not "establish a *prima facie* case of obviousness" and "three basic criteria" have not been met. The Examiner does not use "obviousness" for this rejection. Owens et al. do not disclose that the

exposed part of the raised portion 26 forms a design surface and that the design surface is formed as part of the background surface and is not level with the background surface. However, Owens does indicate that the surface of a raised portion 26 is intended for use in applying information (see Col.3, lines 55-56). Etching and appliqués are both commonly used methods for applying information. Using either one of these methods would have been obvious alternatives, since they are easily performed, and use of either technique would result in a design surface that is “not level with the background. The word “obvious” used for alternatives method to apply information such as etching and appliqués.

Regarding Appellant’s arguments on page 21, the raised portion 26 is clearly seen as an integral part of the housing 12(see Fig. 4). The raised portion 26 is a planar portion having a flat, even surface (see Fig.1, 2 and 4) and provides a space to apply indicia.

Regarding claims 3-7, 11, and 14-16

The examiner’s response to the remaining arguments regarding claims 3 – 7, 11 and 14 – 16 are the same as presented above.

Conclusion

To conclude the discussion regarding claims, the Examiner points out that she tried to say in the rejection of Claims 1 and 12 that Owens et al. reference teaches only one surface, not both: background and designed

surfaces. However, Owens et al. do indicate that the surface of a raised portion 26 is intended for use in applying information (informative plaque) what inherently lead to creation of design surface when using etching and appliquéés, that both commonly used methods of applying info, and would have been obvious alternations since they are easily performed. Use of either technique would result in a design surface that is not level with the background surface;


the Examiner has to repeat again and again that the part of the invention, which includes a manufacturing step (one-step process), is not in the claim language; also the Examiner notes that the every page of Arguments in the Appeal Brief introduced almost the same arguments, which clearly show that Applicant mixed up his invention, which is disclosed into the Specification, and what Applicant really claimed. There is a discrepancy between the Claimed language and Arguments. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

LT
February 9, 2006

Conferees

Darren Schuberg

SPE 2833 

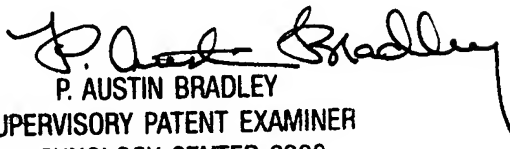
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